

REMARKS

The Examiner has objected to the drawings.

The Examiner has objected to the specification.

The Examiner rejected claims 3-15 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Examiner rejected claims 1, 3-5, 7-11, and 13-15 under 35 U.S.C. 102(b) as allegedly being anticipated by Gerard et al. (U.S. Patent No. 4,561,082).

The Examiner rejected claim 2 under 35 U.S.C. 103(a) as allegedly being unpatentable over Gerard et al. (U.S. Patent No. 4,561,082) in view of Tateishi (U.S. Patent No. 5,636,197).

Applicant respectfully responds to the objections to the drawings and specifications, and Applicant respectfully traverses the §112 and 102(b) rejections, with the following arguments.

Drawings

The Examiner objected to the drawings, alleging that “[t]he proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3/17/03 have been disapproved because they introduce new matter into the drawings. 37CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a “signal separation means” on Fig. 1, block 70.” In response, Applicant has amended FIG. 1, including labeling block 70 as “signal generation means”, which is supported in the originally filed specification on page 4, lines 13-14 (“The sample signal  $S_{CNR}$  is derived from the information signal  $S_{INFO}$  with the aid of the means 70”).

The Examiner further alleged that “[t]he drawings are objected to because Fig. 6B reference numbers, “P1-P7” should be “t1-t7” respectively as disclosed in the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.” In response, Applicant has amended FIG. 6B to change “P1-P7” to “t1-t7” as suggested by the Examiner.

**Specification**

The Examiner objected to the specification, alleging that "[t]he proposed specification corrections, filed on 3/17/03 and not entered, contain insufficient information, such as page "number" and line "number"." In response, Applicant has resubmitted the amendments to the specification, including the pertinent page numbers and line numbers.

**35 U.S.C. 112, First Paragraph**

The Examiner rejected claims 3-15 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner alleged: "Claims 3-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fail to provide support for the inventions as it is claimed. Specifically, the original specification fails to shows the signal separation system recited in claim 9 and discloses in new Fig. 1, block 10. The term "signal separation system" does not appear in the original disclosure and does not support the proposed drawing correction."

In response, Applicant has amended claim 9 for clarification, by changing "signal separation system" to "signal generation system", inasmuch as block 70 of FIG. 1 is a "signal generation means" which is embodied in the signal generation system for generating the signal S<sub>CTRL</sub> as depicted in FIG. 4. Applicant has similarly amended claims 3, 5, 9, 11, 12, and 15.

**35 U.S.C. 102(b)**

The Examiner rejected claims 1, 3-5, 7-11, and 13-15 under 35 U.S.C. 102(b) as allegedly being anticipated by Gerard et al., U.S. Patent No. 4,561,082.

Applicants respectfully contend that Gerard does not anticipate independent claims 1, 3, 9, and 15, because Gerard does not teach each and every feature of claims 1, 3, 9, and 15. For example, Gerard does not teach the feature:

"wherein the sample signal ( $S_{CTRL}$ ) causes the measurement signal (FE) to be sampled at locations having mutually the same intensity level" (claim 1);

"wherein said sample signal causes the measurement signal to be sampled at locations having mutually the same intensity level" (claims 3 and 9); and

"wherein said sample signal causes the measurement signal to be sampled when said intensity is comparatively high" (claim 15).

FIG. 1 of the present patent application shows how  $S_{CTRL}$  controls the sampling of the measurement signal (FE) using control means 40. Most importantly, the preceding feature claims 1, 3, 9, and 15 requires the sample signal ( $S_{CTRL}$ ) to control the sampling of the measurement signal (FE) as a function of the intensity level of information read from the optical information carrier. This feature is illustrated in Applicant's FIG. 4, which depicts a signal generation system 70 that generates the sample signal ( $S_{CTRL}$ ) based on inputs  $S_{INFO}$  and CL, wherein  $S_{INFO}$  reflects the intensity level of information read from the optical information carrier and CL is a clock signal. FIGS. 6A-6C illustrate a concrete example of the generation of  $S_{CTRL}$  as a function of  $S_{INFO}$  and CL in accordance with the signal generation system of FIG. 4.

In contrast with the present invention, Gerard depicts in Figure 5 that a control signal ( $S_A$ ) controls the sampling of a measurement signal ( $V_D$ ) using a sample and hold circuit 110. Figure 5 of Gerard also depicts a signal generation system 12 that generates the sample signal ( $S_A$ ) based on inputs  $V_D$  and  $H$ , wherein  $V_D$  is the measurement signal and  $H$  is a clock signal. Note that the measurement signal ( $V_D$ ) in Gerard is analogous to the measurement signal (FE) in claim 1, inasmuch as  $V_D$  and FE are each indicative of the degree of focusing of the radiation beam at the location of the scanning spot. Most importantly, the control signal ( $S_A$ ) cannot cause the measurement signal ( $V_D$ ) to be sampled at locations having mutually the same intensity level of information read from the optical information carrier (as required by claims 1, 3, 9, and 15), because the signal generation system 12 does not receive any input that characterizes the intensity level of information read from the optical information carrier. The only input received by the signal generation system 12 is  $V_D$  and  $H$ .

In contrast with Gerard as explained *supra*, claims 1, 3, 9, and 15 of the present invention are supported by the specification in which the signal generation system 70 receives as input  $S_{INFO}$ , wherein  $S_{INFO}$  characterizes the intensity level of information read from the optical information carrier.

Based on the preceding arguments, Applicants respectfully maintain that Gerard does not anticipate claims 1, 3, 9, and 15, and that claims 1, 3, 9, and 15 are in condition for allowance. Since claim 2 depends from claim 1, Applicants contend that claim 2 is likewise in condition for allowance. Since claims 4-8 depend from claim 3, Applicants contend that claims 4-8 are likewise in condition for allowance. Since claims 10-14 depend from claim 9, Applicants

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contend that claims 10-14 are likewise in condition for allowance.

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**35 U.S.C. 103(a)**

The Examiner rejected claim 2 under 35 U.S.C. 103(a) as allegedly being unpatentable over Gerard et al. (U.S. Patent No. 4,561,082) in view of Tateishi (U.S. Patent No. 5,636,197). Since claim 2 depends from claim 1, which Applicants have argued *supra* to be patentable under 35 U.S.C. §102(b), Applicants maintain that claim 2 is not unpatentable under 35 U.S.C. §103(a).

**CONCLUSION**

Based on the preceding arguments, Applicant respectfully believes that claims 1-15 meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below.

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